

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/771,519
Attorney Docket No.: A8062

REMARKS

Claims 1-67 are all the claims pending in the application.

I. Summary of the Office Action

The Examiner maintained the rejections of claims 1-13, 15-33, 35-53, 55-63, and 65-67 under 35 U.S.C. § 102(e). The Examiner also found new grounds for rejecting claims 14, 34, 54, and 64. Specifically, claims 14, 34, 54, and 64 stand rejected under 35 U.S.C. § 103(a).

II. Prior Art Rejections under 35 U.S.C. § 102

Claims 1-13, 15-33, 35-53, 55-63, and 65-67 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,631,381 to Couch et al. (hereinafter “Couch”). Applicant respectfully traverses this rejection in view of the following comments.

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. *See* MPEP § 2131.

Of these claims, only claims 1, 21, 41, and 61 are independent. This response will initially focus on these independent claims. For example, claim 1, among a number of unique features, recites “in response to the receipt of the statement for the transaction, automatically generating a private catalog for the transaction to record information about the objects.”

In response to Applicant's arguments, the Examiner alleges that Couch discloses automatically generating a private catalog in response to the receipt of a statement for a transaction in Fig. 8 (specifically, col. 10, lines 26-34 and col. 10, line 63 to col. 11, line 11), *see* pages 6-7 of the Office Action. Applicant respectfully disagrees.

In FIG. 8, Couch discloses a method of integrally referencing a user-generated copy of a catalog in a database system 54. At step 136, the system catalog 88 is generated and populated. As the catalog 88 is integral to the operation of the database 52 and the database system 54, the catalog 88 is typically generated when the database system 54 is installed on the computer station 12B (Fig. 8; col. 10, lines 19 to 26). Next, at step 138, a copy 87, 89 of the catalog 88 is generated. The generation of the copy 87, 89 may be conducted by the database system 54, but is preferably conducted by a user. Multiple copies 87, 89 may be generated. In order to identify the copies 87, 89 names are given to the copies 87, 89. Preferably, these names comprise high-level qualifiers, and are assigned in step 140 (Fig. 8; col. 10, lines 26 to 35).

Couch discloses that the names of catalog tables may comprise a high-level qualifier and one or more low-level qualifiers. A copy of the catalog tables would preferably have a different high-level qualifier than the catalog, but the low-level qualifier would be the same so that the query explain program 50 still understands which catalog table is being accessed (Fig. 8; col. 10, lines 35 to 46). Then, at step 142, the database system component is accessed. Typically, a user wishing to interact with the database system 54 executes a program such as the query explain program 50. At step 144, as disclosed by Couch, the user configures the properties of the database system component including selecting a catalog to be used during the transaction by

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inputting or selecting high level qualifier of the copy of the catalog to be used with the transactions (Fig. 8; col. 10, lines 46 to 63).

Next, at step 148 of Couch, a function of the database system component requiring access to the information within the catalog is executed *i.e.*, a command from a user to execute a function requiring information from the catalog is received. The desired copy of the catalog is then referenced instead of the system catalog, *i.e.* step 150 (Fig. 8, col. 10, line 63 to col. 11, line 11).

In other words, Couch discloses a) generating copies of the catalog, b) assigning names to the catalogs, c) accessing a database system component, d) the user selecting the copy of the catalog to be used (by inputting the name of the catalog *i.e.*, the high level qualifier), and e) executing a function that requires access to the information in the catalog.

Applicant respectfully submits that in Couch, the copy of the catalog is generated prior to accessing the respective database and prior to executing a transaction that would require access to one or more objects in the database. That is, in Couch, copies of the catalogs are generated even prior to accessing a respective data system component. Accordingly, in operation 146, the user needs to select which catalog should be used in executing functional queries.

In short, Couch clearly fails to disclose or suggest automatically generating a private catalog for the transaction to record information about the objects in response to the receipt of the statement for the transaction. Therefore, claim 1 patentably distinguishes from Couch. Since claims 2-13, and 15-20 depend on claim 1, they are patentable at least by virtue of their dependency.

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Independent claims 21, 41, and 61 recite features similar to the features argued above with respect to claim 1. Therefore, those arguments are respectfully submitted to apply with equal force here. For at least substantially analogous exemplary reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claims 21, 41, and 61. Claims 22-33, 35-40, 42-53, 55-60, 62, 63, and 65-67 are patentable at least by virtue of their dependency on claims 21, 41, and 61, respectively.

In addition, with respect to the dependent claims 2-13, 15-20, 22-33, 35-40, 42-53, 55-60, 62, 63, and 65-67, the Office Action indicates that the descriptors are of no patentable consequence (see page 3 of the Office Action). Based on that statement, it appears that the Office Action did not accord any patentable weight to selective elements in the claims *i.e.*, the alleged descriptors. If, on the other hand, the Examiner maintains that all of the unique features in these claims have been considered and are rejected as anticipated by Couch (see pages 8-10 of the Office Action), Applicant respectfully requests the Examiner to specifically point out these unique features in the prior art reference. That is, from this Final Office Action, it is unclear whether the Examiner has found the unique features of the dependent claims in the prior art or did not search for these unique features in the prior art.

Applicant also respectfully submits that MPEP § 2173.01 recites:

Applicant may use functional language, alternative expressions, negative limitations, or **any style of expression or format of claim** which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), **a claim may not be rejected solely because of the type of language used**

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*to define the subject matter for which
patent protection is sought* (emphasis
added) .

Accordingly, Applicant respectfully requests the Examiner to specifically address the dependent claims in the prior art rejection clearly setting forth which features were found in the prior art and which features were regarded of “no patentable consequence.”

Moreover, in response to Applicant’s arguments with respect to claims 7-12, the Office Action indicates that “‘wherein’ clause was given little patentable weight because the language did not refer to a positive recitation of a deleting step forming part of the claimed invention” (*see* page 7 of the Office Action). Claim 9, however, recites: “further comprising deleting the temporary private catalog from the data store after an amount of time required by a system.” That is, claim 9 does not recite a wherein clause but positively recites an additional operation that further defines the invention. The features of claim 9 have not been addressed in the prior art rejection (*see* page 3 of the Office Action). Moreover, Couch does not disclose or suggest *any deletions* of the generated copies of the catalogs. For at least this additional exemplary reason, claim 9 patentably distinguishes from Couch.

III. Prior Art Rejections under 35 U.S.C. § 103

Claims 14, 34, 54, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Couch in view of U.S. Patent No. 5,758,337 to Hammond. Applicant respectfully traverses this rejection in view of the following comments.

Applicant removes Couch, as a § 102(e)/103 prior art reference under 35 U.S.C. § 103(c). Section 103(c) of the U.S. Patent Statute provides that

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“subject matter developed by another person which qualifies as prior art only under one or more subsections (e), (f) and (g) of §102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

This provision, which became effective November 29, 1999 for all applications filed after that date, precludes a commonly owned patent or patent subject to an obligation of assignment to the same person from being prior art under § 102(e)/103.

Applicant respectfully submits that the above-identified application was filed on January 24, 2001, which is after the effective date of this provision (November 29, 1999). With respect to Couch, Applicant respectfully submits that Couch qualifies as a prior art reference only under 35 U.S.C. § 102(e).¹ Applicant further respectfully submits that at the time of the invention, the above-identified application and Couch (including its parent application: 08/949,636) were owned by the same corporation *i.e.*, International Business Machines, or were subject to an obligation of assignment to the same corporation *i.e.*, International Business Machines.

Accordingly, under 35 U.S.C. § 103(c), Couch (including its parent application) may not be applied as a § 103(a) reference. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claims 14, 34, 54, and 64.

¹ The earliest publication date of Couch is the patent issue date of October 7, 2003, which is after the filing date (January 24, 2001) of the above-identified application. Moreover, the parent application (08/949,636) filed October 14, 1997 only qualifies as a prior art reference under 35 U.S.C. § 102(e). The parent application has the earliest publication date of June 5, 2001 (the issue date of the patent). This issue date of the parent application (June 5, 2001) is after the filing date (January 24, 2001) of the above-identified application.


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IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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